

REMARKS

Prior to entry of this response, Claims 1-14 were pending. In the Non-Final Office Action mailed July 10, 2006 Claims 1-14 were rejected. Applicants have amended Claims 1, 4, 7, and 9-10 to clarify that which the Applicants claim as their invention. No claims have been added, or canceled. No new matter has been added by way of this amendment. For at least the reasons discussed below, Applicants submit that the pending claims are patentable over the prior art of record.

Claim Rejections - 35 U.S.C. § 103

Claims 7-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,578,072 to Watanabe et al. in view of U.S. Patent No. 5,987,459 to Swanson et al. Applicants respectfully traverse these rejections.

First, Swanson appears not teach or suggest generating a myriad of second thumbnail images based on the configuration command from the second user - least of all with each second thumbnail image having second dimensions with the second dimensions differing from the first dimensions. Instead, Swanson merely provides for high-quality browsing of retrieval images at low bit rates, but appears to provide no suggestion or teaching of generating a myriad of second thumbnail images as claimed by at least claim 1. See Swanson's Abstract.

Swanson describes a computerized image and document management system for content-based retrieval. A method of Swanson includes extracting a plurality of query objects from at least one input file, coding a set of codewords, each codeword corresponding to a query object, determining instances of each query object, and compressing non-query object data within input files. The files are searchable by any of the query objects. See Swansons' Summary of the Invention, Col. 1, line 50- Col. 2, line 5.

Swanson further discloses a progressive refinement retrieval method that successively reduces a number of searched files as more bits are read, based on a multiresolution technique. See

Swanson, Col. 5, lines 12-20. Swanson's searching method is described in FIGURE 9, and at Col. 11, line 40 through Col 12, line 39. After a careful review of Swanson, Applicant respectfully submits that nowhere does it disclose generating a myriad of second thumbnail images based on a command from the second user. Instead, Swanson describes a user-defined query is in the form of a sample image object - such as query object 174 of Figure 10. See also Swanson, Col. 11, lines 59-60, and Col. 12, lines 28-29. The search begins using the lowest resolution, and by searching all the documents available based on the user-defined query. The resolution does not appear to be a selection by the user. See Swanson, Col. 12, lines 4-14, and Figure 9, block 140. The search proceeds at the set resolution, until no documents are found (block 146) or until **no more than one document** is found (block 150). See Swanson's Figure 9. If more than one document is found, then the method (apparently, again without user intervention) increases the search resolution, and continues to search, until **no more than one document** is found. Thus, nowhere does it appear that Swanson generates a **myriad of second thumbnail images** having second dimensions that differ from the first dimensions, based on the configuration command from the second user. Therefore, Swanson fails to disclose or teach at least this limitation.

Second, Swanson does not teach or suggest displaying a subset of the second thumbnail images, the subset comprising more than one and less than all of the myriad of second thumbnail images, the subset created as a result of input from a third user, as required by at least claim 1. Because Swanson discloses a search that terminates when no more than one document is found, neither Swanson nor Watanabe can provide for a display of a subset of second thumbnail images that comprises **more than one and less than the entire** myriad of second thumbnail images. Simply put, one can not display a subset of something that is not generated! Thus, for at least this reason, neither Swanson alone or in combination with Watanabe discloses at least this limitation.

Third, there is no motivation to combine Watanabe with Swanson, as such combination would not only render Watanabe unsatisfactory for its intended purpose - but may very likely change its principle of operation. Watanabe describes a network photograph service. See Watanabe, Abstract. Watanabe's network photographic service allows a user to request registration

of images, using an image registering function 17 that registers image data read from a film 13 by a scanner 7. The network photograph service further generates low resolution images. The low resolution images are used by the user upon browsing among the images on a screen of his/her personal computer. See Watanabe Col 5, lines 66 to Col. 6, lines 22. Thus, as disclosed, Watanabe's network photograph service automatically creates a low resolution image, without additional input from a first or a second user. As disclosed, Watanabe already uses of a lower resolution image. Swanson's invention therefore does not solve a problem of Watanabe to improve rapid and efficient browsing as stated in the Office Action. Thus, there is no motivation to combine.

Just as important however, is that Swanson's method of searching is configured to provide at most one document based on a user-defined query object. Watanabe, however, is arranged to allow a user to generate an album of images by selecting any images from the images having been registered. See Watanabe, Col. 7, lines 8-34. Thus, combining Swanson would render Watanabe unsatisfactory for its intended purpose of providing albums of many images from the low resolution image database.

It is well-known that "if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01(V). The Applicants respectfully submit therefore that the combination of Watanabe with Swanson does not render the claimed invention obvious. Thus, for at least these reasons, claim 1 should be allowed to issue.

Moreover, independent claims 4, and 10 include similar, albeit different limitations as claim 1. For example, claim 4 recites in part, generating a myriad of second thumbnail images based on the received configuration command, where the second resolution differs from the first resolution, and displaying a subset of the second thumbnail images, the subset comprising more than one and less than all of the myriad of second thumbnail images. Claim 10, recites, in part, changing the thumbnail image to the second size based on the second configuration received from the second user. Because neither Watanabe nor Swanson discloses or suggests changing the thumbnail image

to a second size based on the second configuration from the second user, the cited references do not render claim 10 obvious. Thus, Applicants respectfully submit that, because the cited references do not support a *prima facie* rejection, independent claims 1, 4, and 10 should be allowed to issue.

In addition, because dependent Claims 2-3, 5-6, and 11-14 depend from Claims 1, 4, and 10 respectively, Claims 2-3, 5-6, and 11-14 should also be in condition for allowance for substantially similar reasons.

Claim Rejections - 35 U.S.C. § 103

Claims 7-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Swanson in view of U.S. Patent No. 5,532,839 to Beikirch et al. (hereinafter "Beikirch"). Applicants respectfully traverse these rejections.

Swanson, as disclosed above, discloses a search method that produces no more than one document. Thus, duplicates would likely not be displayed. See Swanson's Figure 9, and related discussion. Furthermore, there is no motivation to combine the cited references because the cited references do not teach "the desirability of the claimed invention." MPEP § 2143.01(I). In particular, Swanson and Beikirch are directed at different technologies, and the problem to which Beikirch is directed is not disclosed or suggested in Swanson. In general, Swanson's system is a completely different technology than Beikirch's digital imagining document handling system. Beikirch discloses automatic detection and deletion of duplicate documents to alleviate "document sheet feeding stoppages." Beikirch, col. 4, line 61. Swanson, however, is directed towards an image and document management system for content-based retrieval. There is no motivation in Swanson for to purge the system of duplicate files. Thus, a desirability of a combination of the cited reference would not have been obvious to one skilled in the art in view Swanson and Beikirch. Therefore, for at least this reason there is no motivation to combine the cited reference, and Claims 7-9 should be in condition for allowance.

CONCLUSION

By the foregoing explanations, Applicants believe that this response has responded fully to all of the concerns expressed in the Office Action, and believes that it has placed each of the pending claims in condition for immediate allowance. Early favorable action in the form of a Notice of Allowance is urged. Should any further aspects of the application remain unresolved, the Examiner is invited to telephone Applicants' attorney at the number listed below.

Dated: October 10, 2006

Respectfully submitted,

By


Jamie L. Wiegand

Registration No.: 52,361

DARBY & DARBY P.C.

P.O. Box 5257

New York, New York 10150-5257

(206) 262-8900

(212) 527-7701 (Fax)

Attorneys/Agents For Applicant